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PAPER NO.

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OFFICE OF PETITIONS

In re Application of :
Moorman et al. :
Application No. 09/885,221 : LETTER REGARDING
Filed: June 20, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. C-2805/5 (PHA :
4166.5)

This is in response to "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR 1.705" filed November 8, 2004. Applicants submit that the present application is subject to a terminal disclaimer, and is therefore not entitled to the benefits of the patent term adjustment under 35 U.S.C. § 154.

The request is **DISMISSED**. However, for the reasons set forth below, the initial determination of patent term adjustment is being corrected to zero (0) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 9, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 20 days. Applicants assert that the patent issuing from this application is not entitled to patent term adjustment on the basis that a terminal disclaimer was filed in this application.

35 U.S.C. 154(b)(2)(B) provides that:

No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

37 CFR § 1.703(g) provides that:

No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under § 1.702 and this section beyond the expiration date specified in the disclaimer.

The provisions of § 154(b), for adjustment due to examination delay, apply to original applications¹, other than designs, filed on or after May 29, 2000. The Office calculates patent term adjustment for examination delay in all eligible applications. In calculating the patent term adjustment, the Office does not differentiate between applications that have terminal disclaimers and those that do not. Nor does the Office undertake the burdensome task of reviewing every application with a terminal disclaimer to determine if the patent term adjustment accorded would adjust the term beyond the expiration date specified in the disclaimer.

Rather, on issuance of the application, in compliance with 35 U.S.C. 154(b) and 37 CFR § 1.703(g), it is indicated in the patent that the patent term adjustment indicated therein is subject to any disclaimer. Moreover, it is also stated therein that the patent is subject to a terminal disclaimer.

However, a review of the application history reveals that the patent term adjustment of 20 days is incorrect. Pursuant to § 1.704(b), the Office should have entered a period of reduction for applicant delay in responding to the final rejection mailed February 14, 2003. Applicants did not file their response, a Request for Continuing Examination (RCE) and amendment, until July 11, 2003, three months and 58 days later. Accordingly, the Office should have entered a period of reduction of 58 days.

In view thereof, the patent term adjustment at the time of the mailing of allowance is zero (0) days.

¹ Since a continued prosecution application (CPA) under § 1.53(d) is a new application, the filing of a CPA application on or after May 29, 2000, in an application filed before May 29, 2000 causes the application (CPA) to be eligible for patent term adjustment.

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Office of Patent Publication for issuance of the application.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen